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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,641	12/05/2000	Ching-Chih (Jason) Han	CREO.009US0	9293
25242	7590	01/27/2005	EXAMINER	
VICTOR H. OKUMOTO P.O. BOX 6120 FREMONT, CA 94538			FIELDS, COURTNEY D	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/730,641

Applicant(s)

HAN ET AL.

Examiner

Courtney D. Fields

Art Unit

2137

-- Th MAILING DATE of this communication appears on the cov r she t with the correspond nc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18, 21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18, 21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1,10,13,16, and 21 have been considered but are moot in view of the new ground(s) of rejection, in view of Dam et al. "Cryptography's Role in Securing the Information Society".

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,10,13,16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. (U.S. Patent No. 6,202,150) in view of Dam et al. "Cryptography's Role in Securing the Information Society". As per claims 1,10,13,16, and 21, Young et al. teaches a method and apparatus for generating encrypted source code of a program, generating a software key to decrypt the encrypted source code, providing the encrypted source code to a recipient, and providing the software key to an escrow holder who is under instructions to provide the software key to the recipient upon satisfaction of a release condition in Column 6, lines 47-67, Column 2, lines 1-60. However, Young et al. does not specifically teach wherein the software key is otherwise unavailable to the recipient at any time. Dam et al. teaches a method for encrypting escrows through the use of authorities vested in escrow agents. This particular approach does not allow the escrow agents known as Data Recovery Centers to hold

user keys or user key components. The product is escrowed Therefore, the key is unavailable to the user at all times as shown in Section 5.3, pages 12 and 13.

As per claim 2, (Young et al. as modified) discloses the claimed limitation wherein the software key is randomly generated while generating the encrypted source code in Column 7, lines 61-67, Column 8, lines 1-5.

As per claims 3, 8,11,14,18, and 23, (Young et al. as modified) discloses the claimed limitation wherein generating binary executable code of the program, and providing the encrypted source code, and the binary executable code of the program to the recipient in Column 8, lines 6-61.

As per claims 5,9, and 12, (Young et al. as modified) discloses the claimed limitation wherein the providing of the software key to the escrow holder includes transferring information of the software key along with an identification of the recipient to the escrow holder in Column 10, lines 34-58. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Young's teachings of auto-escrowable and auto-certifiable cryptosystem and Dam's escrow encryption method. This method will prevent the encrypted key from being available to the escrow holder, by using escrowed encryption allowing software vendors to retrieve the plaintext of encrypted files or other stored information long after the immediate need for such information has passed (See Dam et al., page 12)

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. and Dam et al. further in view of W. Richard Stevens (TCP/IP, Illustrated, Vol. 1). As per claim 1, Young et al. and Dam et al. discloses the invention as claimed above.

However, as per claim 4, Young et al. nor Dam et al. specifically disclose providing the source and binary codes over the Internet using file transfer protocol (FTP). As per claim 4, Stevens teaches FTP is commonly used to transfer files from one system to another. (See page 419) Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Steven's teachings of file transfer protocol (FTP) with Young's auto-escrowable and auto-certifiable cryptosystem and Dam's escrow encryption method. In order to gain the benefits of a protocol that works between different systems, by supporting a number of files types and file structures between the varied systems. (See Stevens, page 419)

5. Claims 6-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. and Dam et al. further in view of Sudia (U.S. Patent No. 5,799,086). As per claims 1 and 13, Young et al. and Dam et al. discloses the invention as claimed above. However, as per claims 6-7 and 15 Young et al. nor Dam et al. specifically disclose providing the key to the escrow holder by email.

As per claims 6,7, and 15, Sudia discloses the claimed limitation wherein the providing of the software key to the escrow holder includes emailing the software key to the escrow holder in Column 40, lines 24-67, Column 41, lines 1-6. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Sudia's enhanced cryptographic system with a key escrow feature with Young's auto-escrowable and auto-certifiable cryptosystem and Dam's escrow encryption method. Sudia's teaching of a cryptographic system with a key escrow

wherein a key is provided to the escrow holder (CA) via email during registration allows the trusted device to communicate with other trusted devices. (See Sudia, Abstract)

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

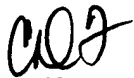
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Courtney D. Fields whose telephone number is 571-272-3871. The examiner can normally be reached on Mon - Thurs. 6:00 - 4:00 pm; off every Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cdf

January 10, 2005



ANDREW CALDWELL  
SENIOR PATENT EXAMINER